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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,616	10/08/2003	Elizabeth M. Andrews	8179-90549	7277

24628 7590 04/19/2005

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EXAMINER

HOEY, ALISSA L

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/681,616	Applicant(s) ANDREWS, ELIZABETH M.	
	Examiner Alissa L. Hoey	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This is in response to amendment received 02/08/05. Claims 1 and 7 have been amended, claim 6 has been cancelled and claims 8 and 9 have been newly added. Claims 1-5 and 7-9 are finally rejected below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaspar et al. (US 4,728,538) in view of Ruth (US 2,424,056).

In regard to claims 1-5 and 7, Kaspar et al. provides a sock article particularly adapted for use in exercises with or without a mat and the exercise is capable of being yoga, pilates or stretching (column 1, lines 17-23). It is inherent that the sock of Kaspar et al. is made out of a natural, plastic or synthetic material. The sock having a layer of rubbery substance on the bottom or sole of the sock which has a sticky or friction characteristics to enable the sock to grip a floor or mat when used by an exerciser (column 1, lines 17-23). The rubbery substance is made out of a latex rubber, silicone rubber, polyurethane or polyisoprene rubber (column 4, lines 9-20). It is inherent that the rubbery

Art Unit: 3765

substance is non-slip. It would have been further inherent that the repeated dot pattern of the grip portions of Kaspar are generally continuous (see figure 2).

However, Kaspar et al. fails to teach the sock having an open front end with webbings extending across the open front end from a top of the sock to a bottom sole of the sock to provide openings through which the toes of a user can extend. The toes are exposed out of the webbings for additional gripping functions on a floor or mat surface. Further, Kaspar et al. fails to teach the sock having four spaced part webbings extending across the open front end between the top of the sock to the bottom of the sole of the sock to provide five specific hole openings in the front end of the sock for receiving the toes of a wearer. Finally, Kaspar et al. fails to teach the rubbery substance being a closed cell PVC vinyl material or a vinyl sponge foam material and the thickness of the rubbery substance being between .065 and .025 inches or .125 inches.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the rubbery substance being a closed cell PVC or vinyl sponge foam material because Applicant has not disclosed that the rubbery substance being a closed cell PVC or vinyl sponge foam material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rubbery substance being a closed cell PVC, vinyl sponge foam material, a latex rubber, silicone rubber, polyurethane or a polyisoprene rubber because as long as the rubbery substance provides frictional grip between the floor and/or

Art Unit: 3765

mat and the user's sock the rubbery substance can be any appropriate rubbery substance. Therefore, it would have been an obvious matter of design choice to modify Kaspar to obtain the invention as specified in claims 2 and 3.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the thickness of the rubbery substance being between .065 and .25 inches or .125 inches because Applicant has not disclosed that the rubbery substance being between .065 and .25 inches or .125 inches provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rubbery substance being between .065 and .25. .125 inches or any other thickness as desired because as long as the rubbery substance provides gripping properties the thickness of the rubbery substance can be any.

Therefore, it would have been an obvious matter of design choice to modify Kaspar to obtain the invention as specified in claims 4 and 5.

Ruth provides a hosiery article (12) having an open front end (13) with webbings (15) extending across the open front end from a top of the sock to a bottom or sole of the sock to provide openings through which the toes of a user can extend (figures 1 and 3). The toes are exposed out of the webbings and are capable of providing additional gripping functions on a floor and/or mat surface. Further, Ruth teaches the hosiery article having four spaced apart webbings (15) extending across the open front end (13) between the top of the sock to the

Art Unit: 3765

bottom of the sole of the sock to provide five specific hole openings (14) in the front end of the sock for receiving the toes of a wearer (figure 1).

It would have been obvious to have provided the sock with non-slip compositions of Kaspar with the toeless hosiery of Ruth, since the sock of Kaspar having a toeless end portion exposing the wearer's toe would allow the article to fit a wide range of foot sizes and will be less likely to develop holes in the foot portions due to the elimination of the toe regions which are subject to the greatest wear.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaspar and Ruth as applied to claims 1 and 7 above, and further in view of Boersema (US 2002/0000003).

Kaspar and Ruth fail to teach the non-slip portions extending around the sides and heel of the sock.

In regard to claim 8, Boersema teaches the non-skid structure extending upwardly on the heel and on each side of the sock a short distance (see figure 3, identifiers 113)

It would have been obvious to have provided the garments of Kaspar and Ruth with the non-skid portions extending into the heel and sides of Boersema, since the article of Kaspar and Ruth provided with non-skid portions extending about the sides and the heel provides an hosiery article that has greater non-skid surface area to prevent one from slipping.

Response to Arguments

5. Applicant's arguments filed 02/08/05 have been fully considered but they are not persuasive. Applicant's remarks have been reviewed by the Examiner and discussed below.

I.) Applicant argues that Kaspar (US 4,728,538) fails to teach the non-skid material on the sole in a generally continuous layer.

Examiner disagrees since the specification does not require the non-skid layer to be continuous or generally continuous. As long as the non-skid layer extends from the open front of the sock to a heel of the sock it can be in a dotted configuration as taught in Kaspar.

II.) Applicant argues that Ruth (US 2,424,056) fails to teach an exercise sock with toe openings and webbings between the toe openings and a generally continuous non-skid material on the bottom sole to facilitate yoga exercises.

Examiner notes that Ruth is used in the rejection with Kaspar to show a hosiery article with toe openings and webbings between the top openings (see figure 1 and 3). The Ruth reference is used in combination with Kaspar and does not teach the non-skid material. The article being an exercise article for use in yoga exercises intended use.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Art Unit: 3765

III.) Applicant argues that Kaspar and Ruth do not disclose a motivation to create applicant's invention. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, it is the Examiner's position to combine the non skid hosiery article of Kaspar with the toe openings and webbings of Ruth. Such a combination would have been motivated by the reasoned expectation that a non-skid sock with toe openings and webbings would provide ventilation and even further friction means by allowing the toes to grip the ground surface. Furthermore, Kaspar and Ruth are both hosiery articles worn on the user's feet.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

Art Unit: 3765


action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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